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3 RECORD OF ORAL HEARING
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 Ex parte HANS-PETER WILD and EBERHARD KRAFT
11

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13 Appeal 2010-002522
14 Application 09/690,409
15 Technology Center 3700
16

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18 Oral Hearing Held: September 16, 2010
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22 Before JOHN C. KERINS, MICHAEL W. O'NEILL and
23 FRED A. SILVERBERG, Administrative Patent Judges.
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26 ON BEHALF OF THE APPELLANT:
27

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1 The above-entitled matter came on for hearing on Thursday,
2 September 16, 2010, commencing at 1:02 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,
4 Alexandria, Virginia, before Lori B. Allen, notary public.

5 JUDGE KERINS: Mr. Pokotilow, do you happen to have a
6 business card you could give our court reporter?

7 MR. POKOTILOW: Oh, sure I do. Just give me a second.
8 There you go.

9 JUDGE KERINS: Thank you very much. A couple of other
10 preliminary matters.

11 We note this hearing is marked as not being open to the public.
12 We have one of our patent attorneys serving on the Board with us here
13 observing today.

14 MR. POKOTILOW: That's no objection, Your Honor.

15 JUDGE KERINS: We have reviewed the record and are
16 generally familiar with the issues, and are looking forward to hearing your
17 argument.

18 MR. POKOTILOW: Thank you. I would just point out I'm
19 Steven Pokotilow from the firm of Stroock & Stroock & Lavan in New
20 York, and Vivian Liu with me is one of my associates. She's never seen an
21 argument before, so she's very excited. She's a second year associate at the
22 firm. And I will try not to go back through and repeat the arguments as
23 they're set forth and try to present what I think is the central issue here.

24 As you know, this invention and all the claims relate to a
25 method and system of adhering a straw package to a foil bag, by way of

1 background, because I think it always provides a little more interest. The
2 foil bags, if you know the product "Capri Sun," that would be the classic
3 product that was invented by my client many years ago, 34 years ago. And
4 my client makes the machines that make these bags today for these kind of
5 returnable pouch products. So the foil bag is significant.

6 The reason it's emphasized in the claims is because the
7 technology of manufacturing these bags, of filling and manufacturing these
8 bags, critical element, and any type of efficiency that can be obtained and
9 any superior product that can be obtained becomes important. Why is it
10 important in this case? Because the method and system that are claimed
11 allow for greater adherence and a faster throughput when you affix the
12 straws to the bag.

13 And, as you'll know from reading the claims and from reading
14 our briefs, without overemphasizing it, obviously, the problem and the
15 solution starts with taking the bag and putting it on its side, rather than as
16 you see in the prior art where everyone was focusing on the bag as it was
17 manufactured standing up on its base. So, now, the challenge is that you
18 want to affix the package of a straw to the bag and you want to do it in a way
19 that's secure. And, so, every limitation -- I'm sorry. Every claim recites as
20 an affirmative limitation the idea of rotating the pivot arm of the lever to
21 displace a depressing arm downward to the conveyor. And when I point to
22 the word, "downward to the conveyor," I think that is, as I frame my
23 argument, the most important point.

24 The reason I say that is because the primary reference that
25 we've argued over, Geysel, doesn't do this. And I would suggest that when

1 we argue there's no prima facie case of obviousness, all the other arguments,
2 obviously, flow from that. The deficiency of Geyssel is critical here, and I
3 would go through three critical points in Geyssel that are discussed by the
4 Examiner to point out why you would not be able to manipulate or change,
5 or modify Geyssel in the way the Examiner proposes, either from a
6 theoretical or from a physical standpoint.

7 That being said we go to the first point made by the Examiner,
8 and that is at page 4 of the Office Action. I'm sorry. Of the Examiner's
9 Answer. In that place, the Examiner says he seems to focus on the fact that
10 he says that Geyssel shows applying a straw package on to the second side
11 wall, of course, of the pouch at an acute angle to the conveyor belt, and he
12 points to Figure 9. And the reason this is interesting is it's not that the straw
13 package in the claimed invention is attached to the package at an acute angle
14 to the conveyor belt.

15 It's that the pressing arm is downwardly applying the force to
16 the straw package, which does, granted, apply it at an acute angle. But, it's
17 the force of that arm, which is affirmatively recited, moving downwardly to
18 the conveyor belt. So we already see that in describing the context of the
19 reference it misses the point when he makes that point.

20 JUDGE KERINS: Mr. Pokotilow, in Figure 9 where we see the
21 acute angle, are not those presser arms moving in a direction which is at
22 least partially downward toward the belt?

23 MR. POKOTILOW: No. Matter of fact, it's moving exactly
24 opposite. It's not moving toward the belt. It's moving away from the belt. If
25 we move toward the belt, I'll get to my next argument shows it would be

1 impossible to rotate it up that much. The angle that it rotates it at has to be
2 an angle at the side wall that's smaller, if you look at it without drawing a
3 projection out. You'll notice that it's actually beyond the belt. It doesn't
4 push it down to the belt, because that's not the purpose of it. The purpose is
5 to sort of create an alignment with the two adhesive spots on the adhesive
6 bag, which is a different method of attachment, because ours, the adhesive,
7 is on the straw package.

8 But, having said that, if you look at it, you'll notice that the
9 angle could never -- the only way you could ever get it to rotate, I grant you
10 -- it rotates sort of in Figure 9 it looks downward, but not at the belt. And I'll
11 make the point as I explain to you why that's significant. And the Examiner
12 says -- it starts with the comment the Examiner makes on page 5 where he
13 says -- he talks about providing. He says, "rotating the pivoting arm of the
14 lever to displace the pressing arm downward toward the conveyor belt to
15 apply a straw package onto the second side wall, and an acute angle to the
16 conveyor belt."

17 And the Examiner speaks of the fact that the transfer drum is
18 rotatable about an axis substantially parallel to the second sidewall. Well, if
19 you go and look at the language in column 3, lines 58 through 59, you will
20 notice that the mechanism in Geyssel says that it's level with the belt. And
21 the Examiner makes the point that it really shows it's slightly above the level
22 of the belt. Well, I'll give you that it's got to be level with the belt and it's
23 got to be level with the package, the object. So we'll give it the benefit of
24 the doubt by saying, yeah, there probably is slightly above, and the
25 limitation would be above the level of the package.

1 But, if you read it, it also says in lines 58 and 59, it says, "but
2 it's also immediately adjacent thereto." Immediately adjacent is because you
3 have to have that lever that moves the straw over that linear movement to the
4 bag. Now, if you were to rotate this mechanism any further than the angle
5 they show in the patent, you would then obscure the objects, because the
6 rotating wheel would be in the way of the belt. So that's an impossibility.

7 So you could never in the first instance rotate it into the space
8 of the conveyor belt, which means above the conveyor belt, to go down to
9 the conveyor belt; but, more importantly, if you did so, to do that rotation
10 you would no longer be "immediately adjacent," which is all that Geyssel
11 teaches. So, therefore, it would not be possible, even though the Examiner
12 suggests that all you have to do is take it up and then rotate it over, becomes
13 an impossibility, because now the objects can't move through the belt. So
14 you've got to consider the fact that they've created an impossibility.

15 It's much easier to visualize, I think, when you look at the
16 reference, if you start rotating that whole mechanism up. Because,
17 remember. You've got to capture the straw that comes out of the wheel
18 immediately adjacent to that station, or you're not going to get any
19 connection, or you're going to miss the point. So it's not like you could take
20 this mechanism and then just swing it up and then drop it.

21 That's why when they show the tilt angle, that tilt angle may be
22 possible for a pouch that is angled, you know, that sits on its base with
23 narrow angles. But the angle that you would need to have it downwardly to
24 the belt, or the conveyor belt, which is what's affirmatively recited in the
25 claim, quite intentionally, by the way, Your Honor, to distinguish over

1 Geyssel is what makes that distinction. So in that sense, we believe that
2 that's a second major distinction.

3 Now, when the Examiner talks about it as that Fig. 9 point, I've
4 already made the point. He says, "The pressing arm of Geyssel is fully
5 capable of being displaced downward toward the conveyor belt as recited."
6 And as I said to you, I honestly believe that it isn't, because in order to be
7 downward to the belt, you'd have to be within the space of the belt, and
8 therefore you'd block the objects looking at the structure. So I think it
9 becomes an impossible combination.

10 So, therefore, he says when the Examiner says on page 9, the
11 Examiner states, and I believe the words he says are, "Accordingly, the straw
12 applicator is designed to be tipped in any desired, angular position, as well
13 as to accommodate the various containers, which can be positioned on the
14 conveyor in any desired angular position. In other words, the depressing
15 arm of Geyssel's apparatus and method is fully capable of being displaced
16 downward toward the conveyor belt as recited."

17 That's your appeal. That's the issue that's the central issue.
18 Now, are there many differences? Does the fact that Geyssel never suggests
19 putting an adhesive on the straw package, that he never concerns himself
20 with the facility and the efficacy of securing the straw to the pouch so that it
21 commercially doesn't release because it's been affixed in a much better way?
22 That's all, you know, part of our arguments on why you wouldn't even look
23 to Geyssel to do this.

1 Geyssel doesn't solve the problem. It doesn't recognize the
2 problem. So, in essence, what we're talking about then is what is it fair to
3 argue you could do with Geyssel?

4 JUDGE KERINS: Counsel, when you say Geyssel doesn't
5 address the problem, isn't Geyssel moving the applicator to a position that's
6 parallel to the side it's applying the straw to? And isn't that what your
7 solution is?

8 MR. POKOTILOW: Isn't he applying? No.

9 JUDGE KERINS: In Figure 9, for example, you have an angle
10 package and you rotated the applicator to the same angle.

11 MR. POKOTILOW: But that's not our invention, first of all.
12 Let's go back to --

13 JUDGE KERINS: I believe that is what your background states
14 that you want the straw to be applied parallel to the surface it's being applied
15 to.

16 MR. POKOTILOW: We wanted to be applied, but we want it
17 with a downward force. That makes a better application. My whole point is
18 if I were claiming only, to use good patent jurisprudence, if I were merely
19 claiming, as a matter of fact, as occurred in the first appeal in this case, were
20 they just claiming applying a straw on an angle, I'm with you. I think
21 Geyssel may have a teaching there.

22 When I get to the point that I'm now creating a new structure
23 and method that applies an improved connection by bringing this
24 mechanism, the pressing arm downwardly to the package, that's not shown
25 in the prior art. No matter how you do it, you're not getting it done. This

1 "downwardly to the belt" can't be done by Geyssel, because if you did, you
2 would be, as I said earlier, you would be obstructing the objects with the
3 wheel that holds all the straw packages.

4 JUDGE KERINS: Well, counsel, what do you consider then
5 the arms in the Geyssel patent? What direction do you consider them
6 moving?

7 MR. POKOTILOW: They are moving at an angle that is
8 uninclined; and, if you looked at this way, if this is the pouch and this is the
9 wall, at this angle, because you can't rotate it into the space.

10 JUDGE KERINS: Well, how about how are the arms relative
11 to the belt? How are they moving?

12 MR. POKOTILOW: Well, first of all, they're moving linearly.
13 They're not moving toward -- they're moving linearly, because remember.
14 There's another limitation which says, "rotating." They don't rotate the arms
15 in Geyssel. What they do is they do two linear movements. They push this
16 up, which causes a ballast to move this way and move the arm laterally or
17 linearly this way. And, as I said, at an angle, at an angle, and you might
18 even argue at a slightly downward angle, but not at the belt, not toward the
19 belt. It can't. Because in order to get that downward force that comes onto
20 the straw package onto the package you'd have to be above the package.

21 JUDGE KERINS: So, counsel, I understand you're saying
22 downwardly towards the belt. Maybe this didn't come out clearly in your
23 brief. You're saying downwardly towards the belt means it has to be
24 positioned directly above the belt?

1 MR. POKOTILOW: Well, it has to be above. With one word,
2 I worry about that -- not directly above it, but above the belt and above the
3 package -- and it's not above the package. And it can't be above the package,
4 because when we're above the package, it wouldn't be immediately adjacent
5 and it would obscure the package because the wheel would be in the way.
6 That's what I'm really saying.

7 Now, look. We worked very hard to try to come up with words
8 and verbiage to distinguish this over Geyssel from a mechanical, rotational
9 standpoint. And, you know, I could spend my whole life trying to convince
10 you all that, you know, the art is inapplicable and they don't solve the
11 problems and all that. But I think that, you know, I go back to my days as
12 an Examiner 4,000 years ago where, you know, you look at the claim. You
13 look at the limitations and you look at the prior art and you say is this a fair
14 reading of the prior art. And it's not a fair reading of the prior art.

15 That angularity was done in order to allow, in figs. 7 and 8,
16 alignment of the straw, and in fig. 9 to accommodate the fact that you might
17 have what they call tipping. And the term, "tipping," is very clearly used in
18 the Geyssel patent; not rotating the whole system, because it couldn't be. As
19 I said, I hate to keep harping on this point, but if you rotate it, you'll get in
20 the way of the object, so you can't be above the package. And I think when
21 you use the word "directly above," since that's not in the claims, I will
22 concede that point. But I will concede that it's got to be positioned to direct
23 it downward to the pouch, and that's my point.

24 JUDGE KERINS: With your arm motions you're indicating
25 perpendicularly down. Is that it?

1 MR. POKOTILOW: Yes. Yes, I am. And perhaps as I said,
2 you know, again, this limitation of downward to the belt versus what
3 Geyssel shows are just sort of this angle that's slightly downward, but not to
4 the belt, is to me a significant distinction, and I believe within the scope of
5 the claim that should be allowable over Geyssel, given all the deficiencies.
6 In other words, I think we could all come to some understanding that
7 Geyssel doesn't teach a lot of this. I mean Geyssel doesn't recognize.
8 Geyssel is really about spacing the connectors and doesn't really concern
9 itself as we do with the quality of the affixation and the facility with which
10 it's affixed.

11 You could argue that to the extent that Geyssel teaches adding a
12 straw, it's a kluge. The idea that you've got to move this item and then move
13 it down and then move it back, it's a kluge, where my client's whole system,
14 which is claimed in its entirety, which starts with moving the bag to its side,
15 is a much more simple and elegant approach. And it's clean. I don't have a
16 forward claim that says moving it downward. I have a lot of limitations. I
17 have a lot of elements, and I've got a reference that the Examiner has really,
18 to use the term "tortuously," reconstructed in a way that you can't do.

19 It's not rotatable. If the words in the Specification of Geyssel
20 mean anything, "immediate and adjacent" should inform this board that you
21 can't do what he says he's doing. So the best you've got is fig. 9. Fig. 9
22 doesn't do the job, because it doesn't move it downwardly towards the belt.
23 You know. If you said "substantially vertically to the belt," I don't know.
24 That might be another way of approaching it. He doesn't do that either, but
25 the claims are what they are, because we tried to get some engagement and

1 we couldn't. And as long as Geyssel is substantially the proposition that
2 anybody that ever puts a straw in a bag in any new way is not going to get a
3 patent.

4 I didn't make that argument, because I think you guys have read
5 the record. So once you decide that Geyssel doesn't do the job because of
6 that limitation in each claim that's on appeal, all the other arguments then
7 speak for themselves, no prima facie obviousness. Oh, by the way, and once
8 you also realize that Geyssel doesn't rotate the arm down, that lack of
9 rotation which was also missing, I thought I'd point that out, because that's
10 how you get your downward movement in our thing to get the placement of
11 the straw package on the bag. But, once you have that, you'll look at it and
12 then you'll say to yourself. Okay. What else do we have?

13 Well, we say no prima facie obviousness. We also say why
14 would you combine the two references. And, by the way, combining the two
15 references, the Wild patent, which is the secondary reference, is quite
16 frankly our client's own patent. We know what the problems are with that.
17 The only reason the Examiner cites Wild, is because Wild puts the adhesive
18 on the straw. Unfortunately, Wild does it on a package that stands up and it
19 does it in batch mode and not in conveyor mode. So it really doesn't add
20 much, although it does.

21 I can tell you what it adds. My client's business is a lot better,
22 because they figured out this problem with connecting the straws the way it
23 does now, and sells the machines, and they're a lot more efficacious. So all
24 I'm suggesting is that all those arguments about not solving the problem, not
25 recognizing the problem, are quite clearly stated in the brief, and I don't want

1 to rehash those, because I'm sure that every brief you read has the same law
2 and the same, whatever. But, I do think these arguments in my experience
3 usually come down to a real kind of meeting of the minds on what the
4 reference fairly teaches. And I'm pulling my hair out, because Geysse
5 doesn't teach it and my clients have been very frustrated by it and asked me
6 to take this appeal and make me spend my time with you all today discussing
7 it for that reason.

8 I don't know how much time I have left, but --

9 JUDGE KERINS: Just a minute or two.

10 MR. POKOTILOW: Just a minute or two. Are there any
11 questions you all have?

12 JUDGE KERINS: Judge O'Neill, do you have some more?

13 MR. POKOTILOW: No? Well, I think you know how I feel
14 about this.

15 JUDGE KERINS: Thank you very much, Mr. Pokotilow.

16 MR. POKOTILOW: You're welcome.

17 Whereupon, at 1:23 p.m., the proceedings were concluded.

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